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RICK MATOS PHD
2200 ALL SAINTS LANE
PLANO TX 75025

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OFFICE OF PETITIONS

In re Application of :
Yosef Freedland :
Application No. 09/753,128 :
Filed: December 30, 2000 :
Attorney Docket No. JST-15 :
ON PETITION

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed June 3, 2005 (supplemented on June 20, 2005).

The petition under 37 CFR 1.181 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.181".

As set forth in MPEP 711.03(c)(I), a petition to withdraw the holding of abandonment is appropriate in those instances where an applicant contends that the application is not in fact abandoned. However, where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), the appropriate remedy is a petition to revive the abandoned application under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay).

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed September 9, 2003, which set a shortened statutory period for reply of three (3) months. This final Office action was properly mailed to the correspondence address of record at that time. Applicant does not deny having received the final Office action. On November 24, 2003, applicant filed an amendment, together with a "Revocation of Existing Power of Attorney and New Power of Attorney", signed by applicant Yosef Freedland. The power of

attorney was not entered by the Office. The Office mailed an Advisory Action to the old correspondence address on January 9, 2004, informing applicant that the November 24, 2003 amendment would not be entered because it failed to place the application in condition for allowance. In addition, the Advisory Action informed applicant that the period for reply remained from the date set forth in the September 9, 2003 Office action. No further proper reply with an appropriate extension of time having been received, the application became abandoned on December 10, 2003. A Notice of Abandonment was mailed on February 7, 2005.

Applicant requests that the holding of abandonment be withdrawn and that the finality of the September 9, 2003 Office action be changed to non-final status. Both requests are dismissed.

As set forth above, the September 9, 2003 final Office action was properly mailed by the Office to the correspondence address of record. As set forth in the Manual of Patent Examining Procedure MPEP 711.03(c)(II):

Evidence of nonreceipt of an Office communication or action (e.g. Notice of Abandonment **or an advisory action**) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment [or advisory action]."¹

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113. 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal.

Applicant should have ensured that the amendment had been entered or applicant should have filed either a Request for Continued Examination (RCE), continuing application, or Notice of Appeal. The last day an RCE, continuing application, or Notice of Appeal could have been filed, with the maximum allowed three month extension of time, would have been March 9, 2004.

With respect to applicant's argument that the finality of the September 9, 2003 Office action be changed to non-final status, applicant is directed to MPEP 706.07(c), which states that "any question as to the prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner". It is noted that applicant did not raise

¹ MPEP 711.03(c)(II) (emphasis added).

this issue in his November 24, 2003 response. Furthermore, applicant is directed to MPEP 706.07(a), which states that an examiner may introduce a new ground of rejection in a final Office action where it was "necessitated by applicant's amendment of the claims".

Alternate Venues:

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(1) - currently \$250 for a small entity; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m) - currently \$750 for a small entity; (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

The change of correspondence address filed May 22, 2005 has been entered. A courtesy copy is being mailed to the address on the petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

By FAX: 571-273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision may be directed to the undersigned at 571-272-3207.


Cliff Congo
Petitions Attorney
Office of Petitions

cc: Yosef Freedland
64/6 Trumpeldor St
Petach Tikvah 49403 Israel